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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,324	09/15/2003	Harold D. Beck	03-11	3791
30699	7590	06/20/2006		
DAYCO PRODUCTS, LLC 1 PRESTIGE PLACE MIAMISBURG, OH 45342				
			EXAMINER AUGHENBAUGH, WALTER	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/663,324</p>	<p><b>Applicant(s)</b> BECK ET AL.</p>	
	<p><b>Examiner</b> Walter B. Aughenbaugh</p>	<p><b>Art Unit</b> 1772</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 1-4,6-10 and 20-22.
- Claim(s) withdrawn from consideration: none.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

## **ADVISORY ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. The After Final Amendment filed June 6, 2006 has not been entered because the deletion of "as the tubular structure" in the third line of claim 20 raises new issues that would require further consideration and/or search. Deletion of this phrase introduces a method of use limitation in claim 20: the tubular structure of line 1 is no longer required to be the tubular structure recited in lines 3-12 with this deletion. Lines 3-4 recite a method step of employing the tubular structure recited in lines 3-12, where no relationship between the tubular structure of line 1 and the tubular structure recited in lines 3-12 is required (for example, the tubular structure of line 1 need not be the same tubular structure as the tubular structure recited in lines 3-12: one tubular structure could be inside the other, or the two tubular structures could be different components in a device which are located in different regions of that device). A 35 U.S.C. 112, second paragraph rejection of claim 20 would be necessary, if the After Final Amendment was entered, since that which Applicant intends to recite cannot be ascertained due to at least the points raised above (for example, does Applicant intend, or does Applicant not intend, the tubular structure of line 1 and the tubular structure recited in lines 3-12 to be the same tubular structure?), and since claim 20 provides for the use of the tubular structure recited in lines 3-12, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim 20 would also have to be rejected under 35 U.S.C. 101, if the After Final Amendment was entered, because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

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definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Response to Arguments***

2. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claims 1-4, 6-10 and 20-22 presented on pages 8-16 of the After Final Amendment have been fully considered but are not persuasive.

On page 9 of the After Final Amdt., Applicant argues that saponified ethylene vinyl acetate saponified to a degree of 90% is not ethylene vinyl acetate copolymer. However, Applicant correctly states on page 10 that saponified ethylene vinyl acetate saponified to a degree of less than 100% is an ethylene-vinyl acetate-vinyl alcohol terpolymer. Ethylene-vinyl acetate-vinyl alcohol terpolymer is an ethylene vinyl acetate copolymer, so saponified ethylene vinyl acetate saponified to a degree of 90% is "an ethylene vinyl acetate copolymer" as claimed in claim 1.

On page 9 of the After Final Amdt., Applicant states that Igarashi et al. "specifically state that if the degree of saponification is less than 90 mol %, the heat resistance of the product formed of the resinous composition tends to be lowered to an unsatisfactory level". Igarashi et al. does not "specifically state" this. The level is described as "insufficient" (col. 3, lines 39-47). Regardless, the teaching of Igarashi et al. that the heat resistance "tends to be lowered to an unsatisfactory level" is inconclusive and therefore does not teach away from Applicant's claimed subject matter.

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In regard to Applicant's discussion regarding the CPA resin of Igarashi et al. on page 10 of the After Final Amdt., claim 1 does not exclude another resin, such as CPA resin, from the scope of the claim.

Applicant's statement that "[g]as relates to the state of the material" and the related statements in lines 2-6 of page 10 of the After Final Amdt. are unsupported: Applicant has not provided convincing evidence showing that Igarashi et al. intends "gas" to refer solely, or at all, to "the state of the material".

In regard to Applicant's discussion regarding the CPA resin of Igarashi et al. on page 11 of the After Final Amdt., claim 1 does not exclude another resin, such as CPA resin, from the scope of the claim.

Applicant's statement on page 12 of the After Final Amdt. that "[t]he saponified ethylene-vinyl acetate copolymer of Igarashi et al is more appropriately characterized as being a CPA-ethylene-vinyl acetate-saponified vinyl acetate (vinyl alcohol) terpolymer when the degree of saponification is less than 100%" is incorrect (and unsupported). Igarashi et al. teach that CPA is blended with the saponified ethylene-vinyl acetate copolymer (col. 3, lines 55-63). A blend of polymer A and polymer B is not a copolymer of polymer A and polymer B (Igarashi et al. do not teach a "CPA-ethylene-vinyl acetate-saponified vinyl acetate (vinyl alcohol) terpolymer").

Applicant's arguments regarding claims 8 and 9 presented on pages 12-13 of the After Final Amdt. depend entirely upon Applicant's arguments regarding the rejection of claim 1 which have been addressed above.

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Claim 10 does not recite that the copolymer “ha[s] a vinyl acetate content of up to about 90% based on the weight of the copolymer” as Applicant seems to state on page 13 of the After Final Amdt.

On page 13 of the After Final Amdt., Applicant argues that saponified ethylene vinyl acetate saponified to a degree of 90% is not ethylene vinyl acetate copolymer. However, Applicant correctly states on page 10 (and similarly suggests on page 13) that saponified ethylene vinyl acetate saponified to a degree of less than 100% is an ethylene-vinyl acetate-vinyl alcohol terpolymer. Ethylene-vinyl acetate-vinyl alcohol terpolymer is an ethylene vinyl acetate copolymer, so saponified ethylene vinyl acetate saponified to a degree of 90% is “an ethylene vinyl acetate copolymer” as claimed in claim 10.

On page 14 of the After Final Amdt., Applicant states that Igarashi et al. “specifically state that if the degree of saponification is less than 90 mol %, the heat resistance of the product formed of the resinous composition tends to be lowered to an unsatisfactory level”. Igarashi et al. does not “specifically state” this. The level is described as “insufficient” (col. 3, lines 39-47). Applicant’s statement as to what is “indicat[ed]” by, and what “one can infer” from, the teaching at col. 3, lines 43-47 is unsupported. Regardless, the teaching of Igarashi et al. that the heat resistance “tends to be lowered to an unsatisfactory level” is inconclusive and therefore does not teach away from Applicant’s claimed subject matter.

On page 15 of the After Final Amdt., Applicant argues that saponified ethylene vinyl acetate saponified to a degree of 90% is not ethylene vinyl acetate copolymer. However, Applicant correctly states on page 10 (and similarly suggests on pages 13 and 15) that saponified ethylene vinyl acetate saponified to a degree of less than 100% is an ethylene-vinyl acetate-vinyl

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alcohol terpolymer. Ethylene-vinyl acetate-vinyl alcohol terpolymer is an ethylene vinyl acetate copolymer, so saponified ethylene vinyl acetate saponified to a degree of 90% is “an ethylene vinyl acetate copolymer” as claimed in claim 1.

On page 15 of the After Final Amdt., Applicant states that Igarashi et al. “specifically state that if the degree of saponification is less than 90 mol %, the heat resistance of the product formed of the resinous composition tends to be lowered to an unsatisfactory level” and reverts back to addressing claim 10 in doing so. Igarashi et al. does not “specifically state” this. The level is described as “insufficient” (col. 3, lines 39-47). Regardless, the teaching of Igarashi et al. that the heat resistance “tends to be lowered to an unsatisfactory level” is inconclusive and therefore does not teach away from Applicant’s claimed subject matter.

Applicant’s arguments regarding claims 21 and 22 presented on pages 15-16 of the After Final Amdt. depend entirely upon Applicant’s arguments regarding the rejection of claim 1 which have been addressed above.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

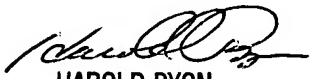
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh  
06/13/06

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1772

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